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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/077,305	02/15/2002	Albert Eugster	GR-47	3405

7590 01/26/2005  
Friedrich Kueffner  
317 Madison Avenue  
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EXAMINER

DEUBLE, MARK A

ART UNIT	PAPER NUMBER
3651	

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

 <b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/077,305	EUGSTER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Mark A. Deuble	3651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,3 and 5-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3 and 5 is/are rejected.
- 7) ☒ Claim(s) 6-8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. ____.  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____.   | 6) <input type="checkbox"/> Other: ____.                                    |

## **DETAILED ACTION**

### ***Reopening Prosecution***

1. In view of the appeal brief filed on October 25, 2004, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31. A new notice of appeal fee and appeal brief fee will not be required for applicant to appeal from the new Office action. Any appeal brief filed on or after September 13, 2004 must comply with 37 CFR 41.37.

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3, and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boss (U.S. Patent No. 5,277,413) in view of Merwarth et al. (U.S. Patent No. 5,046,711) or Muller (U.S. Patent No. 5,110,108).

Boss shows a conveying arrangement for processing printed material on a conveying member 42 supplying printed material to an intermediate conveying device 9 which in turn

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supplies printed material to a synchronously operated feeder 1 arranged downstream of the intermediate conveying device. The intermediate conveying device has a plurality of compartments 4 formed by two plates 16 and 14 that are adjustable relative to each other and that are rotating about an axis of rotation 10. In operation, the compartments are moved into an open position for receiving printed material when approaching the conveying member and then into a closed position for further transporting the received printed material. Because the plate member 16 moves upward relative to the to the plate member 14, it may be considered to be liftable when that word is given its broadest reasonable interpretation. Conveying means formed by rollers 22 and 34 are arranged opposite one another on the two opposed adjustable plates so that they may transport frictionally the printed material clamped between the rollers out of the compartment. While the plates do not have through openings of the type shown in Fig. 2 of the present application, it is clear that the rollers 34 and 22 project from openings formed in the ends of members 16 and 14 as may be seen in Fig. 2 of Boss. A drive configured to act on the conveying means if formed by a stationary roller path 28 and a drive roller 30a connected to the rollers 22 through linkage 32-33 so that the rollers 22 eject the printed material when the drive roller 30a is acted upon by the roller path. Thus Boss shows all the structure required by claims 1-5 except for the pocket shaped receiving elements on the synchronously operating feeder required by claim 1 and for the yielding roller cover of claim 5.

It should be noted, however, that both Merwarth et al. and Muller teach that pocket shaped receiving elements on a synchronously operating feeder may advantageously be used to receive printer material from a rotary transfer device in the manner of the present invention. Therefore it would have been obvious to one of ordinary skill in the art at the time of the

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invention to replace the saddle shaped receiving elements of Boss with pocket shaper receiving elements. When this is done, the result apparatus would have all the structure required by claims 1 and 3.

Furthermore, the use of cam roller having a elastic or yieldable surface to prevent slippage between the cam roller and the cam surface is also well known in the art and therefore is deemed to have been an obvious design choice absent some disclosure in the applicant's specification of some unusual advantage or result. *In re Kuhle*, 188 USPQ 7 (CCPA 1975).

#### ***Allowable Subject Matter***

3. Claims 6-8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark A. Deuble whose telephone number is (703) 305-9734. The examiner can normally be reached on Monday through Friday except for alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher P Ellis can be reached on (703) 308-2560. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

md

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